

Traversal of Restriction Requirement

In the restriction requirement presented in the Office Action, it was determined that the inventions of Groups I-V are separate and distinct. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, the restriction requirement presented in the Office Action has involved a determination at least implicitly that the inventions of the various groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper.

Furthermore, it follows that, should prior art be found that anticipates the invention of one of the groups, the inventions of the other groups would be patentable over such art because the determination has been made in the Office Action that the inventions of the groups are separately patentable over one another. If this were not the case, then, as mentioned above, the restriction requirement would not be proper. As indicated above, the M.P.E.P. states that distinct inventions are patentable, i.e., novel and unobvious, over each other. Applicant recognizes that the M.P.E.P. does further state, "though they each may be unpatentable because of the prior art." However, this language must only mean that there may be prior art that renders one of the inventions unpatentable and other prior art the renders another of the inventions unpatentable. The language cannot mean that prior art anticipating one of the inventions would also anticipate or render obvious the other inventions. If so, then the inventions of the separate groups would not be patentable over one another. Thus, each invention of the various groups must be novel and unobvious over the inventions of the other groups. Otherwise, Applicant has the right to have all inventions, which are not novel and not unobvious over one another, examined in the same application.

The following analysis is presented for the sake of argument and should not be construed in any way as an admission as to the patentability of the present claims over any prior art. Take, for example, Group III, which has Claim 26 directed to a kit for determining the presence of an analyte, comprising the reagent of Claim 25 (Group II)

and a second specific binding pair member as recited in the claim. Since, according to the determination in the Restriction Requirement, the invention of Claim 26 is separately patentable, i.e., novel and unobvious, over the invention of Claim 25, then it follows that prior art that might anticipate Claim 26 would not anticipate or render obvious the invention of Claim 25. In other words, prior art that might disclose a reagent as set forth in Claim 25 together with a second specific binding pair member as defined in Claim 26 would not anticipate or render obvious the reagent of Claim 25. In accordance with the reasoning in the Restriction Requirement, the reverse would also hold, namely, prior art that might disclose a reagent as set forth in Claim 25 and not a second specific binding pair member, would not anticipate or render obvious the kit of Claim 26. If the above were not true, i.e., if such prior art would relate to the patentability of both Claims 25 and 26, then the restriction requirement would not be proper. The above discussion would also apply to the separate patentability of, for example, Group IV over Groups II and III, respectively, as well as to the separate patentability of other groups in relation to one another.

Election of Invention

In response to the Restriction Requirement and as required by the Office Action, Applicant elects the invention of Group I, Claims 1-24, as set forth in the original Restriction Requirement.

In making the above election, Applicant reserves the right to file divisional applications to the separately patentable non-elected subject matter as determined in the Office Action.

Election of Species

The Office Action also required Applicant to make the following species elections:

A. Select one sensitizer from the following:

1. photosensitizer (Claims 2-6),
2. enzyme sensitizer (Claims 7-8), or
3. electron transfer catalyst (Claims 7-8).

B. Select one detection method from the following:

1. third binding pair member (Claim 9),
2. third and fourth binding pair members (Claims 10-12 and 16-20),
3. labeled competitor (Claims 13-14), or
4. unmasked binding site (Claims 15 and 21-24).

In response thereto Applicant elects the following species: A1 - photosensitizer (Claims 2-6) and B1 - third binding pair member (Claim 9). Claims readable thereon are Claims 1-6 and 9.

The Office Action indicated that, if Applicant should traverse the above election on the ground that the species are not patentably distinct and if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. It follows from this statement and (consistent with the discussion above with regard to the Restriction Requirement) that, if the species are patentably distinct as has been determined in the Office Action, prior art (if any) that anticipates or renders obvious one of the inventions cannot anticipate or render obvious the other inventions. If this were not the case, then the election of species would not be proper. It should be noted as mentioned above that the foregoing analysis is presented for the sake of argument and should not be construed as an admission as to the patentability, or the lack thereof, of the present claims over any prior art.

It has been held that a requirement for election of species is tantamount to a restriction requirement. Accordingly, Applicant reserves the right to file divisional patent applications to all of the species that the Examiner has determined are patentable over one another. See also M.P.E.P. 806.04(h).

Applicant acknowledges the indication in the Office Action that, upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species that are written in dependent form or otherwise include all the limitations of an allowed generic claim.

SUMMARY

Applicant has traversed the Restriction Requirement. In addition, Applicant, as required in the Office Action, has elected the subject matter of Group I in response to the original Restriction Requirement. Finally, as required in the Office Action, Applicant has elected a single disclosed species for examination on the merits.

Respectfully submitted,

A handwritten signature in black ink, reading "Theodore J. Leitereg". The signature is written in a cursive style with a large, stylized "T" and "L".

Theodore J. Leitereg
Attorney for Applicant
Reg. No. 28,319

Theodore J. Leitereg, P.C.
31420 Pennant Ct.
Temecula CA 92591
(602) 369-1751